

9200/1618  
96700/451

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants : Bruce D. Gaynor, et al.  
Serial No. : 08/833,838  
Filed : April 10, 1997  
For : PEPTIDES FOR THE TREATMENT AND DIAGNOSIS OF LUPUS  
ERYTHEMATOSUS  
Examiner : Not Assigned  
Group Art Unit : Not Assigned



#4

"Express Mail" mailing label No. EL375538560US

Date of Deposit: September 17, 1999

I hereby certify that this paper or fee is being deposited with the United States Postal Service "Express Mail Post Office to Addressee" service under 37 CFR 1.10 on the date indicated above and is addressed to the Assistant Commissioner for Patents, Washington, D.C. 20231.

Name: Sharon Kelly

Signature: Sharon Kelly

COMMUNICATION REQUESTING WITHDRAWAL  
OF ERRONEOUSLY ISSUED NOTICE OF ABANDONMENT

Assistant Commissioner for Patents  
Washington, D.C. 20231

Attn: Office of Petitions

Sir:

Applicants hereby submit this Communication Requesting Withdrawal of the Notice of Abandonment that was erroneously issued by the U.S. Patent Office on October 6, 1998. In this regard, enclosed please find copies of the following:

(a) the Communication in Response to the Notice to File Missing Parts timely filed with the Patent and Trademark Office on December 3, 1997, including a copy of the October 6, 1997 Notice to File Missing Parts; an executed Declaration and



Applicants : Bruce D. Gaynor, et al.  
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OF SYSTEMIC LUPUS ERYTHEMATOSUS

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Power of Attorney; a check in the amount of \$953.00 to cover the \$65.00 surcharge fee, the \$385.00 filing fee, and the \$503.00 claims fee, all for a small entity; a First Class Mailing Certificate; and a return receipt postcard (Exhibit A);

(b) the stamped postcard receipt indicating the timely receipt by the U.S. Patent Office of the Communication in Response to the Notice to File Missing Parts (Exhibit B);

(c) a Notice of Abandonment dated October 6, 1998 (Exhibit C); and

(d) a Communication Requesting Withdrawal of the Erroneously Issued Notice of Abandonment filed with the U.S. Patent Office on January 4, 1999 (Exhibit D).

The circumstances surrounding the erroneous abandonment of the subject application are as follows. On October 6, 1997, the Patent Office issued a Notice to File Missing Parts of Application in connection with the subject application. On December 3, 1997, Applicants timely filed a Communication in Response to the Notice of Missing Parts (Exhibit A), including a copy of the October 6, 1997 Notice to File Missing Parts; an executed Declaration and Power of Attorney; a check in the amount of \$953.00 to cover the \$65.00 surcharge fee, the \$385.00 filing fee, and the \$503.00 claims fee, all for a small entity; a First Class Mailing Certificate; and a return receipt postcard. Applicants' attorneys received the stamped postcard receipt indicating timely receipt of the Communication by the U.S. Patent Office (Exhibit B).

The first page caption of the Communication in Response to the Notice to File Missing Parts correctly identified the (i) Applicants, (ii) filing date, and (iii) title of the Application. However, there was an inadvertent typographical error in the first page

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caption of the Communication which incorrectly identified the Application Number of the parent application to the subject application, namely Application No. 08/531,832. As a result, the U.S. Patent Office failed to match the Communication in Response to the Notice of Missing Parts with the file of the subject application, and erroneously issued a Notice of Abandonment (Exhibit C) in connection with the subject application on October 6, 1998.

The error was compounded when on January 4, 1999, Applicants submitted a Communication to Withdraw the Erroneously Issued Notice of Abandonment (Exhibit D) which again correctly identified the Applicants, filing date and title in the first page caption but incorrectly identified the Application Number. The Communication to Withdraw the Erroneously Issued Notice of Abandonment included a copy of the Notice of Abandonment and the stamped return receipt postcard indicating timely receipt by the U.S. Patent Office of the Communication in Response to the Notice to File Missing Parts.

The typographical error was subsequently discovered by the Applicants when Applicants received a Communication from the Patent Office in connection with the parent application, namely Application No. 08/531,832, which stated "[a]fter careful review of evidence submitted, it was noted that the abandonment belongs to another application that the applicant has filed. The Notice of Abandonment letter indicates serial number 08/833,838 which the Notice of Abandonment is for that application."

Hence, it is apparent that the Communication in Response to the Notice of

Applicants : Bruce D. Gaynor, et al.  
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Missing Parts and the subsequent Communication Requesting Withdrawal of the Erroneously Issued Notice of Abandonment were not matched up with the subject application file due to a typographical error in the first page caption of both Communications. However, Applicants respectfully note that the first page caption of both Communications correctly identified the Applicants, the filing date, and the title of the subject application. Further, the Communication in Response to the Notice of Missing Parts enclosed a copy of the Notice to File Missing Parts issued in connection with the subject application, as well as a signed Declaration and Power correctly identifying the Applicants, the filing date, the title, and the Application Number for the subject application. Therefore, there were ample identifiers connecting both Communications with the subject application. Hence, the Communication in Response to the Notice of Missing Parts should have been matched up with the subject application and the Notice of Abandonment should not have been issued.

Accordingly, Applicants respectfully submit that the Notice of Abandonment dated October 6, 1998 should be withdrawn and the subject application should be restored to pending status.

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Applicants : Bruce D. Gaynor, et al.  
Serial No. : 08/833,838  
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No fee is deemed necessary in connection with the filing of this Communication. If, however, any fee is required, authorization is hereby given to charge the amount of any such fee to Deposit Account No. 01-1785.

Respectfully submitted,

AMSTER, ROTHSTEIN & EBENSTEIN  
Attorneys for Applicants  
90 Park Avenue  
New York, New York 10016  
(212) 697-5995

Dated: September 17, 1999  
New York, New York

By   
Alison R. Kelly  
Prov. Registration No. P44,821



96700/451

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants : Bruce D. Gaynor, Betty A. Diamond,  
Matthew D. Scharff and Philippe Valadon

Serial No. : ~~08/531,832~~ <sup>833,838</sup>

Filed : April 10, 1997

For : PEPTIDES FOR THE TREATMENT AND DIAGNOSIS  
OF SYSTEMIC LUPUS ERYTHEMATOSUS

COMMUNICATION IN RESPONSE TO NOTICE  
TO FILE MISSING PARTS OF APPLICATION

Assistant Commissioner of Patents  
Washington, D.C. 20231

Sir:

I hereby certify that this correspondence is being  
deposited with the United States Postal Service at  
First Class Mail in an envelope addressed to:  
Commissioner of Patents and Trademarks,  
Washington, D.C. 20231 on the date which appears  
below:

*Heidi Renner*  
Signature  
12/3/97  
Date of Signature and Deposit

In response to the Notice to File Missing Parts of  
Application dated October 6, 1997, copy attached, Applicants  
enclose the following:

1. a copy of the October 6, 1997 Notice to File Missing  
Parts;
2. an executed Declaration and Power of Attorney; and
3. a check in the amount of \$953.00 to cover the \$65.00  
surcharge fee, the \$385.00 filing fee, and the \$503.00  
claims fee, all for a small entity. Applicants' small  
entity status was established in the parent application,  
U.S. Serial No. 08/531,832, and is still applicable.

Adjustment date: 02/08/2000 MVILLARI  
12/19/1997 NGORDON#800000058 08531832

01 FC:205 -65.00 OP  
02 FC:201 -395.00 OP  
03 FC:197 -493.00 OP

02/08/2000 MVILLARI 00000001 08833838

01 FC:201  
02 FC:202  
03 FC:203  
04 FC:205

385.00 OP  
360.00 OP  
143.00 OP  
65.00 OP

Applicants: Bruce D. Gaynor, Betty A. Diamond,  
Matthew D. Scharff and Philippe Valadon  
Serial No.: 08/833,838  
Filed : April 10, 1997  
Page 2

Authorization is hereby given to charge any deficiency or  
credit any overpayment in the enclosed fees to Deposit Account No.  
01-1785. A duplicate copy of this letter is enclosed.

Respectfully Submitted,

AMSTER, ROTHSTEIN & EBENSTEIN  
Attorneys for Applicants  
90 Park Avenue  
New York, New York 10016  
(212) 697-5995

Dated: December 3, 1997  
New York, New York

By Elizabeth A. Bogosian  
Elizabeth A. Bogosian  
Registration No. 39,911



UNITED STATES DEPARTMENT OF COMMERCE  
Patent and Trademark Office

Address: COMMISSIONER OF PATENTS AND TRADEMARKS  
Washington, D.C. 20231

| APPLICATION NUMBER | FILING/RECEIPT DATE | FIRST NAMED APPLICANT | ATTORNEY DOCKET NO./TITLE |
|--------------------|---------------------|-----------------------|---------------------------|
|--------------------|---------------------|-----------------------|---------------------------|

06/803,336 04/10/97 GATBUP

AMSTER POTHESTEIN & ERENSTEIN  
90 PARK AVENUE  
NEW YORK NY 10016



DATE MAILED: 1615

**NOTICE TO FILE MISSING PARTS OF APPLICATION**  
**Filing Date Granted**

An Application Number and Filing Date have been assigned to this application. However, the items indicated below are missing. The required items and fees identified below must be timely submitted **ALONG WITH THE PAYMENT OF A SURCHARGE** for items 1 and 3-6 only of \$ 130.00 for a ☒ large entity ☐ small entity in compliance with 37 CFR 1.27. The surcharge is set forth in 37 CFR 1.16(e). Applicant is given **TWO MONTHS FROM THE DATE OF THIS NOTICE** within which to file all required items and pay any fees required above to avoid abandonment. Extensions of time may be obtained by filing a petition accompanied by the extension fee under the provisions of 37 CFR 1.136(a).

**If all required items on this form are filed within the period set above, the total amount owed by applicant as a**  
☒ large entity ☐ small entity (verified statement filed), is \$ 190.00.

☒ 1. The statutory basic filing fee is:

- ☒ missing.  
☐ insufficient.

Applicant must submit \$ 770.00 to complete the basic filing fee and/or file a verified small entity statement claiming such status (37 CFR 1.27).

☒ 2. Additional claim fees of \$ 100.00, including any multiple dependent claim fees, are required.

Applicant must either submit the additional claim fees or cancel additional claims for which fees are due.

☒ 3. The oath or declaration:

- ☒ is missing.  
☐ does not cover the newly submitted items.  
☐ does not identify the application to which it applies.  
☐ does not include the city and state or foreign country of applicant's residence.

An oath or declaration in compliance with 37 CFR 1.63, including residence information and identifying the application by the above Application Number and Filing Date is required.

☐ 4. The signature(s) to the oath or declaration is/are:

- ☐ missing.  
☐ by a person other than inventor or person qualified under 37 CFR 1.42, 1.43, or 1.47.

A properly signed oath or declaration in compliance with 37 CFR 1.63, identifying the application by the above Application Number and Filing Date, is required.

☐ 5. The signature of the following joint inventor(s) is missing from the oath or declaration:

An oath or declaration listing the names of all inventors and signed by the omitted inventor(s), identifying this application by the above Application Number and Filing Date, is required.

☐ 6. A \$ \_\_\_\_\_ processing fee is required since your check was returned without payment (37 CFR 1.21(m)).

☐ 7. Your filing receipt was mailed in error because your check was returned without payment.

☐ 8. The application does not comply with the Sequence Rules.

See attached "Notice to Comply with Sequence Rules 37 CFR 1.821-1.825."

☐ 9. OTHER:

Direct the response and any questions about this notice to "Attention: Box Missing Parts."

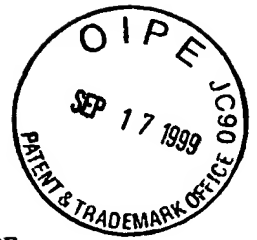
**A copy of this notice MUST be returned with the response.**

Customer Service Center  
Initial Patent Examination Division (703) 308-1202



96700/451

The stamp of the Patent Office Mail Room herein acknowledges the receipt of the above identified document on the date indicated by such stamp.



Inventors: Bruce D. Gaynor, et al.

Title: PEPTIDES FOR THE TREATMENT AND DIAGNOSIS OF

In re. SYSTEMIC LUPUS ERYTHEMATOSUS  
(Applicant or Parties)

08/531,832

Atty: EAB / gr

(Serial No. or Proceeding No.)

Communication in Response to Notice to File Missing Parts (2 pages); executed Declaration and Power of Attorney (2 pages); check in the amount of \$953.00; and a First Class Certificate of Mailing stamp dated December 3, 1997.

AMSTER, ROTHSTEIN & EBENSTEIN  
90 PARK AVENUE  
NEW YORK, NEW YORK 10016

1-2  
210

No 38345

| REMITTANCE ADVICE |  |
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96700/451

DOLLARS

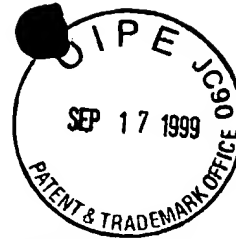
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| PAY<br>AMOUNT                        | TO THE ORDER OF | DATE | DESCRIPTION | CHECK NO. | CHECK AMOUNT |
|                                      |                 |      |             | 38345     | 953.00       |
| Commissioner of Patents & Trademarks |                 |      |             |           |              |

*[Signature]*  
AUTHORIZED SIGNATURE

THE CHASE MANHATTAN BANK, N.A. - 80 EAST 42nd STREET - NEW YORK, NEW YORK 10017

⑈038345⑈ ⑆021000021⑆ 007 1 263842⑈





96700/451

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants : Bruce D. Gaynor, Betty A. Diamond,  
Matthew D. Scharff and Philippe Valadon

Serial No. : 08/531,832

Filed : April 10, 1997

For : PEPTIDES FOR THE TREATMENT AND DIAGNOSIS  
OF SYSTEMIC LUPUS ERYTHEMATOSUS

COMMUNICATION REQUESTING WITHDRAWAL OF ERRONEOUSLY  
ISSUED NOTICE OF ABANDONMENT

Honorable Commissioner of  
Patents and Trademarks  
Washington, D.C. 20231

Sir:

I hereby certify that this correspondence is being  
deposited with the United States Postal Service  
as First Class Mail in an envelope addressed to  
the Assistant Commissioner for Patents,  
Washington, D.C. 20231 on the date which  
appears below:

Signature: Guy Penner

Date: 1/4/99

Applicants hereby submit this Communication in response  
to the Notice of Abandonment dated October 6, 1998 which was  
erroneously issued by the U.S. Patent and Trademark Office in  
connection with the above-identified application. Applicants have  
attached hereto as Exhibit A a copy of the October 6, 1998 Notice  
of Abandonment.

In the October 6, 1998 Notice, the Examiner indicated  
that the subject application is abandoned in view of applicants'  
failure to respond to the October 6, 1997 Notice to File Missing  
Parts.

Applicants: Bruce D. Gaynor, Betty A. Diamond,  
Matthew D. Scharff and Philippe Valadon  
Serial No.: 08/833,838  
Filed : April 10, 1997  
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Accordingly, applicants would like to direct the Examiner's attention to the return postcard submitted with applicants' Communication in Response to Notice to File Missing Parts, a copy of which is attached hereto as Exhibit B. The return postcard indicates that the Communication, executed Declaration and Power of Attorney, and a check in the amount of \$953.00 were mailed to the U.S. Patent and Trademark Office on December 3, 1997 and received by the U.S. Patent and Trademark Office on December 8, 1997.

In view of the preceding remarks, applicants maintain that the October 6, 1997 Notice to File Missing Parts was timely responded to and was received by the U.S. Patent and Trademark Office. Accordingly, applicants respectfully request that the October 6, 1998 Notice of Abandonment be withdrawn and the application be restored to active status.

No fee is deemed necessary in connection with the filing of this Communication. If, however, any fee is required,

Applicants: Bruce D. Gaynor, Betty A. Diamond,  
Matthew D. Scharff and Philippe Valadon  
Serial No.: 08/833,838  
Filed : April 10, 1997  
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authorization is hereby given to charge the amount of any such fee  
to Deposit Account No. 01-1785.

Respectfully Submitted,

AMSTER, ROTHSTEIN & EBENSTEIN  
Attorneys for Applicants  
90 Park Avenue  
New York, New York 10016  
(212) 697-5995

Dated: January 4, 1999  
New York, New York

By Elizabeth A. Bogosian  
Elizabeth A. Bogosian  
Registration No. 39,911

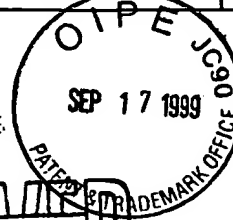


UNITED STATES DEPARTMENT OF COMMERCE  
Patent and Trademark Office  
Address: COMMISSIONER OF PATENTS AND TRADEMARKS  
Washington, D.C. 20231

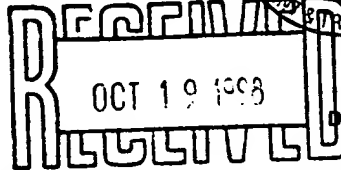
| APPLICATION NUMBER | FILING/RECEIPT DATE | FIRST NAMED APPLICANT | ATTORNEY DOCKET NO./TITLE |
|--------------------|---------------------|-----------------------|---------------------------|
| 08/803,829         | 04/10/97            | GAYNOR                | 8 96700/451               |

AMSTER ROTHSTEIN & EBENSTEIN  
90 PARK AVENUE  
NEW YORK NY 10016

NM21/1006



NOT ASSIGNED



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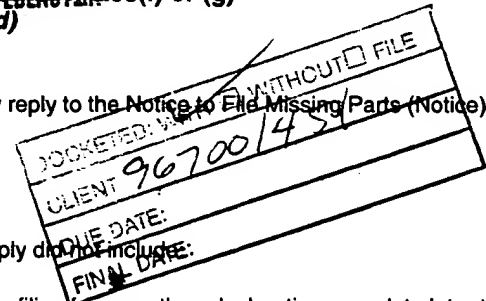
DATE MAILED:

10/06/98

**NOTICE OF ABANDONMENT UNDER 35 U.S.C. 153(f) or (g)**  
(Filing Date Granted)

The above-identified application is abandoned for failure to timely or properly reply to the Notice to File Missing Parts (Notice) mailed on 10-06-97.

- ☒ No reply was received.
- ☐ The reply received on \_\_\_\_\_ was untimely.
- ☐ The reply received on \_\_\_\_\_ was improper. The reply did not include:
- ☒ 1. The surcharge under 37 CFR 1.16(e) required for filing the basic filing fee or oath or declaration on a date later than the filing date of a nonprovisional application.
- ☐ 2. The surcharge under 37 CFR 1.16(i) required for filing the basic filing fee or cover sheet on a date later than the filing date of a provisional application.
- ☒ 3. The full amount of the basic filing fee under 37 CFR 1.16 (a), (f), (g), (k).  
(Note: A nonprovisional application may not be relied on for benefits under 35 U.S.C. 120 and 37 CFR 1.78 unless the processing and retention fee set forth in 37 CFR 1.21(l) is paid within the one year period set forth in 37 CFR 1.53(f). A provisional application may not be relied on for benefits under 35 U.S.C. 119(e) and 37 CFR 1.78 unless the basic filing fee is paid).
- ☐ 4. The oath or declaration of all the inventors required under 37 CFR 1.63 for this nonprovisional application.
- ☐ The letter of Express Abandonment filed on \_\_\_\_\_ is acknowledged; however, the application is abandoned for failure to timely or properly reply to the Notice as indicated above.

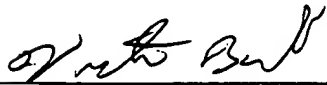


A petition to the Commissioner under 37 CFR 1.137 may be filed requesting that the application be revived.

Under 37 CFR 1.137(a), a petition requesting the application be revived on the grounds of **UNAVOIDABLE DELAY** must be filed promptly after the applicant becomes aware of the abandonment and such petition must be accompanied by: (1) a statement that the entire delay was unintentional; (2) the required reply to the above-identified Notice; (3) the petition fee set forth in 37 CFR 1.17(m); and (4) a terminal disclaimer if required by 37 CFR 1.137(c).

Under 37 CFR 1.137(b), a petition requesting the application be revived on the grounds of **UNINTENTIONAL DELAY** must be filed promptly after applicant becomes aware of the abandonment and such petition must be accompanied by: (1) a statement that the entire delay was unintentional; (2) the required reply to the above-identified Notice; (3) the petition fee set forth in 37 CFR 1.17(m); and (4) a terminal disclaimer if required by 37 CFR 1.137(c).

Any questions concerning petitions to revive should be directed to "Office of Petitions" at (703) 305-9282.

  
Customer Service Center  
Initial Patent Examination Division (703) 308-1202



The stamp of the Patent/Trademark/Copyright Office Mail Room hereon acknowledges the receipt of the below-identified document(s) on the date indicated by such stamp.

Client/Matter No.: 96700/451 Exp. Mail No.: \_\_\_\_\_

Date Mailed: 1/4/99 Atty.: EAB Sec.: gr

In re: Inventors: Bruce D. Gaynor, Betty A. Diamond, Matthew D. Scharff and Philip Valadon

Title: PEPTIDES FOR THE TREATMENT AND DIAGNOSIS OF SYSTEMIC LUPUS ERYTHEMATOSUS

Serial No.: 08/531,832

Title of Document(s) Forwarded: Communication Requesting Withdrawal Of Erroneously Issued Notice of Abandonment; a copy of the October 6, 1998 Notice of Abandonment (Exhibit A); a copy of the return postcard submitted with applicants' Communication In Response to Notice to File Missing Parts (Exhibit B); and a First Class Certificate of Mailing Stamp dated January 4, 1999.

\_\_\_\_\_  
\_\_\_\_\_  
\_\_\_\_\_



96700/451

The stamp of the Patent Office Mail Room hereon acknowledges the receipt of the above identified document on the date indicated by such stamp.

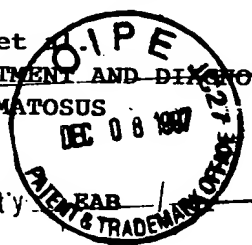
Inventors: Bruce D. Gaynor, et al.

Title: PEPTIDES FOR THE TREATMENT AND DIAGNOSIS OF  
In re. SYSTEMIC LUPUS ERYTHEMATOSUS  
(Applicant or Parties)

08/531,832

(Serial No. or Proceeding No.)

Att'y



Communication in Response to Notice to File Missing Parts (2 pages); executed Declaration and Power of Attorney (2 pages); check in the amount of \$953.00; and a First Class Certificate of Mailing stamp dated December 3, 1997.

